

REMARKS**I. Status of the Claims**

Claims 1, 4, 6, 8, 11, and 14 are pending. Claims 2, 3, 5, 9, 10, 12, 13 and 15 – 25 are canceled. Amendments have been made to claim 1 based upon an interview conducted by telephone with the Examiner on May 31, 2006. The amendments to claim 1 are supported by the instant specification at page 4, lines 14-15; page 5, lines 11-13; and Table 4. It is believed that no new matter has been entered.

At the outset, Applicants believe the amendments to claim 1 places the present application in condition for allowance. Therefore, the amendments should be entered and made of the record.

II. Summary of the Interview

Applicants wish to thank the Examiner for the courtesy extended in granting a telephone interview on May 31, 2006 to discuss the outstanding Office Action. During the interview, the Examiner maintained his position that the claim limitations are inherent in view of the prior art rejections under 35 U.S.C. 103. The Examiner indicated a willingness to reconsider his rejection of claim 1 if the claim were limited to a beryllium-free embodiment. No agreement was reached during the interview as to the claims.

III. Claims Rejections under 35 U.S.C. 103

The Examiner has rejected claims 1, 4-8, 11 and 14 under 35 U.S.C. 103 as being obvious over U.S. 6,139,651 (Bronfin et al.). The Examiner found Bronfin to generally teach the instantly claimed invention and found the properties that are claimed to be inherent in the compositions taught in Bronfin.

Applicants traverse this rejection and submit that a person skilled in the art could not possibly have been led to the present invention as presently claimed from the teaching of Bronfin et al. In the first instance, there is no teaching or suggestion in Bronfin of an alloy which is beryllium-free. Secondly, all of the examples in Bronfin teach the employment of beryllium without any exception. As stated earlier, the Examiner indicated a willingness to reconsider his rejection of claim 1 if claim 1 were amended to exclude beryllium. Accordingly, claim 1, has been amended and now explicitly excludes beryllium. It is respectfully submitted that the specification as originally cited on page 4, lines 14-15, recites that the inventive alloy can be made without beryllium. See also page 13, line 16, which explicitly states that most of the new alloys were cast as beryllium free. In contrast Bronfin teaches beryllium as a required element in each alloy. Clearly, based on this alone, a person skilled in the art would have been led by the teaching of Bronfin to an alloy which includes beryllium. Moreover, there is no suggestion or motivation in Bronfin to exclude beryllium. Accordingly, Applicants submit that the present

invention as claimed in claims 1, 4, 6, 8, 11, and 14 is clearly patentable over Bronfin et al and the rejection based on Bronfin et al, taken alone, should be withdrawn.

Claims 1, 4-8, 12 and 14 stand rejected under 35 U.S.C. 103 as being obvious over US 2001/0023720 (Ohori et al.). The Examiner also rejected claims 1, 4-6, 12 and 14 as being obvious over EP 1127950. Both set of rejections are respectfully transversed. It is believed that EP 1127950 is an English-language equivalent to US 2001/0023720, which has been confirmed by a search of the EPO database. Therefore, EP 1127950 will be discussed with reference to its US counterpart.

According to the Examiner, Ohori teaches Mg alloy compositions which overlap with the instant invention and considers the properties claimed in the instant invention to be inherent from the teaching of Ohori. Regarding the aluminum (Al) content, the Examiner found that despite the 0.1% difference between what is claimed and what is taught in the prior art, the claimed range is obvious to a person skilled in the art.

Applicants submit that a person skilled in the art would not have been led to the present invention from the teaching in Ohori. Since Ohori explicitly teaches an alloy which contains -- "2 to 6% by weight of aluminum" -- and expressly teaches away from an alloy having above 6% by wt aluminum. Applicants refer the Examiner to MPEP 2141.02, subsection (VI) entitled "Prior art must be considered in its entirety, including disclosures that teach away from the claims". It is believed the

Examiner did not consider Ohori in its entirety, because he focuses his analysis solely on the maximum 6% value disclosed in Ohori and disregards all other teaching in Ohori to the contrary. However, the first line of MPEP 2141.02 (IV) recites:

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

In his rejection, the Examiner relies only on the 6% recited in Ohori and argues that based on the proximity of this number to 6.1% the claimed range would have been obvious. But a closer examination of Ohori teaches using values which do not exceed a maximum of 6%. Ohori, at paragraphs [0022] and [0023], recites the following:

[0022] However, when the Al content exceeds 6% by weight, the creep properties rapidly deteriorate. On the contrary, when the Al content is less than 2% by weight, the above effects (effect of improving the tensile strength of the alloy by solid-solution hardening, effect of improving the creep properties) are poor. Particularly, when the Al content is less than 2% by weight, the resulting alloy is liable to have low strength and poor practicability.

[0023] In light of the background described above, the Al content in Ohori was limited to a range of from 2 to 6% by weight inclusive. This range of from 4.0 to 6% by weight is inclusive and does not permit extending the range to cover 6.1% by weight.

The first sentence in paragraph [0022] clearly teaches a bias against values above 6%. The remaining portions of this paragraph and paragraph [0023] show preferred values, all of which are below 6%. Applicants further iterate this point and submit that Ohori teaches, more precisely, values which do not exceed 6.0%. In support of this conclusion, Applicants refer the Examiner to Tables 1 and 2 of Ohori. In every example found in these tables, Al is shown to the tenth decimal place. Each one of the examples using an embodiment of Ohori's invention, teach Al to have a value which is not above the precise value of 6.0. Moreover, Ohori was precise to the tenth decimal place, and even with this precision, there is still no basis to suggest a value above 6.0. Accordingly, it is unclear how a person skilled in the art would have been led to the instantly claimed value of "6.1 to 9.2 wt% aluminum" when every value disclosed in Ohori is expressly limited to 6.0 or less. Therefore, it is respectfully submitted that claims 1, 4, 6, 8, and 14 are not rendered obvious and this rejection should be reconsidered and withdrawn.

Turning to the Examiner's reliance on inherency, Applicants would remind the Examiner that to rely on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The Examiner argues that in view of Ohori, the properties of the instant invention would be inherent. However, Applicants submit that the Examiner makes this assumption but without factual support and, in fact,

contrary to the express teaching in Ohori. In addition, Applicants submit there is nothing in Ohori to suggest an alloy having an "ultimate tensile strength (UTS) of from 244 to 275 MPa at ambient temperature" as is now set forth in Claim 1. Moreover there is no basis from which the Examiner can suggest inherency.

The Examiner alleges that the alloy of Ohori based upon the principal of inherency has the same properties as the instant invention. However, Applicants turn the Examiner's kind attention to Table 3 of Ohori and the column labeled "tensile strength". This table discloses a range of values from 89 to 225. The highest noteworthy value found in Table 4 of Ohori discloses 233 for "Test Embodiment 1". These values are clearly outside the instantly claimed range. If the Examiner's argument based on inherency were correct, then Ohori should have taught a range of values for ultimate tensile strength necessarily within the instantly claimed range. If the properties of the instant invention are inherent in view of Ohori, then Ohori should teach these same properties in the instantly claimed range, or at a minimum, within the claimed range. Ohori does not show this range of values for tensile strength at all as the values are all outside the claimed range, so it is certainly possible for an alloy not to have the properties alleged by the Examiner. Moreover, there are many properties in which the alloy of the present invention is superior over the prior art. Even if a difference in a property appears small a person skilled in the art will understand that this difference in all of the properties, including ultimate tensile strength, tensile yield strength, and minimum creep rate cannot be

attributable to the teaching in Ohori. As already emphasized, the present invention comprises numerous elements that are combined to provide an alloy which is superior in nearly all of the properties. Accordingly, Applicants submit that the Examiner's argument on inherency is untenable and should be withdrawn.

Accordingly, in view of the amendments to claim 1 and the foregoing remarks, Applicants submit these rejections to be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments to the claims and remarks, it is respectfully submitted that the present invention as defined in claims 1, 4, 6, 8, 11, and 14 is in full compliance with all the statutory requirements of Title 35 USC, and therefore, it is earnestly requested that the Examiner's rejections be withdrawn and that the pending claims be passed to issue.

Respectfully submitted
Attorney for Applicant,

Dated: July 7, 2006

By: 

Eugene Lieberstein
Registration No. 24,645

CUSTOMER NO. 01109

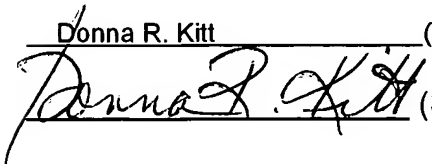
ANDERSON KILL & OLICK, P.C.
1251 Avenue of the Americas
New York, New York 10020-1182
(212) 278-1000

CERTIFICATE OF MAILING

I hereby certify that this *Amendment and Request for Reconsideration* is being deposited with the United States Postal Service via First Class Mail addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 7, 2006.

Donna R. Kitt

(Typed or printed name of person mailing paper or fee)



(Signature of person mailing paper or fee)